

1c803 U.S. PTO
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PTO/SB/50 (4/98)
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Assistant Commissioner for Patents Box Patent Application Washington, DC 20231	Attorney Docket No.	IAFG 12 RE
	First Named Inventor	Bernard BELLEAU
	Original Patent Number	5,532,246
	Original Patent Issue Date (Month/Day/Year)	July 2, 1996
	Express Mail Label No.	

APPLICATION FOR REISSUE OF: (check applicable box) ☒ Utility Patent ☐ Design Patent ☐ Plant Patent

APPLICATION ELEMENTS	ACCOMPANYING APPLICATION PARTS
1. <input type="checkbox"/> * Fee Transmittal Form (PTO/SB/56) (Submit an original, and a duplicate for fee processing)	7. <input checked="" type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) (if applicable)
2. <input checked="" type="checkbox"/> Specification and Claims (amended, if appropriate)	8. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations
3. <input type="checkbox"/> Drawing(s) (proposed amendments, if appropriate)	9. <input type="checkbox"/> English Translation of Reissue Oath/Declaration (if applicable)
4. <input type="checkbox"/> Reissue Oath / Declaration (original or copy) (37 C.F.R. § 1.175)(PTO/SB/51 or 52)	10. <input type="checkbox"/> * Small Entity Statement filed in prior application, Statement(s) Status still proper and desired (PTO/SB/09-12)
5. Original U.S. Patent <input type="checkbox"/> Offer to Surrender Original Patent (37 C.F.R. § 1.178) (PTO/SB/53 or PTO/SB/54) or <input type="checkbox"/> Ribboned Original Patent Grant <input type="checkbox"/> Affidavit / Declaration of Loss (PTO/SB/55)	11. <input type="checkbox"/> Preliminary Amendment
6. Original U.S. Patent currently assigned? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No (If Yes, check applicable box(es)) <input type="checkbox"/> Written Consent of all Assignees (PTO/SB/53 or 54) <input type="checkbox"/> 37 C.F.R. § 3.73(b) Statement <input type="checkbox"/> Power of Attorney	12. <input checked="" type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
	13. <input checked="" type="checkbox"/> Other: <u>Transmittal of Reissue Application</u>

* NOTE FOR ITEMS 1 & 10: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).

14. CORRESPONDENCE ADDRESS					
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NAME (Print/Type)	Harry B. Shubin	Registration No. (Attorney/Agent)	32,004
Signature	<i>Harry B. Shubin</i>	Date	June 2, 2000

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of : Box: REISSUE
Bernard Belleau et al. : Group Art Unit:
Original Patent No.: 5,532,246
Serial No.: Not Yet Issued : Examiner: Jerome D. Golberg
Filed: Herewith :
For: **USE OF 1,3-OXATHIOLANE NUCLEOSIDE ANALOGUES IN THE
TREATMENT OF HEPATITIS B**

JC714 U.S. PTO
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TRANSMITTAL OF REISSUE APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

SIR:

Transmitted herewith is an application for reissue of U.S. Patent No. 5,532,246,
originally issued on July 2, 1996.

U.S. Patent 5,532,246 is currently involved in Interference No. 104,396 and 104,524.
This reissue application is being added to the former interference by Motion under 37 C.F.R.
§1.633(i) and (h).

The application seeks a reissue of U.S. Patent No. 5,532,246 to add claims 10-15 and
thereby provide protection for subject matter narrower in scope than the presently claimed
subject matter. The subject matter in new claims 10-15 is disclosed in the specification. See,

e.g., column 1, lines 47-61; column 2, lines 4-32 and 43-47; column 4, lines 4-7 and 12-15; and column 7, lines 6-7 and 49-59. Thus, claims 10-15 do not constitute new matter.

The subject matter sought to be claimed by new claims 10-15 is of an intermediate scope. The claimed subject matter was part of the subject matter originally disclosed in the application, but was not specifically claimed. Furthermore, the subject matter of claims 10-15 is within the scope of independent claim 1 of the patent.

Applicants believe their original patent U.S. Patent No. 5,532,246 is wholly or partly inoperative by reason of the patentees failing to contain claims of intermediate scope. Such claims of intermediate scope can provide a "hedge" against invalidity arguments that might be raised by third parties (as has occurred in Interference 104,396). See, e.g., *See In re Handel*, 136 U.S.P.Q. 460 (CCPA 1963), and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 11 U.S.P.Q.2d 1750 (Fed. Cir. 1989), sanctioning such intermediate claims in a reissue application as "error."

Submitted with this Transmittal are:

- Reissue Patent Application Transmittal Form PTO/SB/50.
- The specification of the reissue application in accordance with 37 C.F.R. §1.173, indicating new claims 10-15. Note that the reissue application has been amended to incorporate the corrections listed on the five page Certificate of Correction.

Respectfully submitted,



Anthony J. Zelano, Registration No. 27,969
Attorney for Applicants

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Filed: June 2, 2000

I hereby certify that a true copy of the following were served:

1. Reissue Application Transmittal Form PTO/SB/50
2. TRANSMITTAL OF REISSUE APPLICATION
3. The specification of the reissue application.

to

Samuel Abrams, Esq.
PENNIE & EDMONDS
1155 Avenue of the Americas
New York, NY 10036-2711

via Federal Express overnight delivery this 2nd day of June, 2000.



Anthony J. Zelano

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